

REMARKS

The applicant notes with appreciation the acknowledgement of the claim for priority under section 119 and the notice that all of the certified copies of the priority documents have been received.

The applicant acknowledges and appreciates receiving an initialed copy of the forms PTO-1449 that were filed on June 19, 2001 and May 23, 2001.

Claims 1 – 3, 7, 9 and 11 – 13 are pending. Claims 4 – 6, 8 and 10 have been canceled. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1, 2, 4 and 6 – 10 were rejected under 35 USC 102(e) as being anticipated by U.S. Patent No. 5,931,878, Chapin Jr. (“Chapin”). Claims 3 and 5 were rejected under 35 USC 103(a) as being unpatentable over Chapin. Insofar as the rejection may be applied to the claims as amended, the applicant respectfully requests that this rejection be withdrawn for reasons including the following, which are provided by way of example.

The specification recognizes the problem of “supplying vehicle information such as maintenance management information and parts information specific to each vehicle.” (Specification page 2, lines 2 - 5.) Claim 1 as amended recites in combination, for example, “storing in first storage means, of the information center, maintenance management information of a vehicle owned by a user, the maintenance management information being received from the user through the communication network; storing in second storage means, of the information center, maintenance work information regarding maintenance work which are provided by an advertisement requestor; linking the maintenance management information and the maintenance work information in the information center to extract a content of the maintenance work of the

advertisement requestor which corresponds to a maintenance work required by the vehicle of the user; and transmitting, from the information center to the information terminal through the communication network, a message indicative of an arrival of a maintenance time based on the maintenance management information and advertisement requestor information regarding the advertisement requestor which provides the extracted maintenance work.” (Claim 1; see also claims 7, 9.) Thereby, both the maintenance management information and maintenance work information are stored in an information center; and the maintenance time is determined by the information center and transmitted by the information center to an information terminal 2 through a network.

Without conceding that Chapin discloses any feature of the present invention, Chapin is directed to computerized prompting systems, which provide “a simple maintenance reminder and scheduler for use by personal computer users.” (Col. 2, lines 48 – 50.) According to Chapin, vehicle information supply is executed between a user terminal 10 – 20 and an external device 24, through a network 22. Chapin’s user terminal 10-20 has a database 10 regarding maintenance information and determines a maintenance time.

The office action asserts that Chapin discloses the invention as claimed. To the contrary, Chapin fails to teach or suggest the invention, as presently claimed, when the claims are considered as a whole. Chapin fails to teach or suggests, for example, storing both maintenance management information and maintenance work information, where maintenance time is determined and transmitted from the information center (where the maintenance management information and maintenance work information are stored) to the information terminal through the network. (See, e.g., claims 1, 7, 9.) To the contrary, Chapin does not determine the maintenance time and transmit the maintenance time. Moreover, Chapin does not store the

maintenance management information and maintenance work information as recited in the information center.

Chapin fails to teach or suggest, for example, these elements recited in independent claims 1, 7 and 9. It is respectfully submitted therefore that claims 1, 7 and 9 are patentable over Chapin.

The examiner argues that various elements are inherent in Chapin with respect to claims 6, 7, 8, 9, and 10. To the extent that the inherency argument is maintained against the amended claims 7 and 9, the contentions that linking as recited, reception of maintenance information as recited, necessary parts being requested by the user, and the storage medium storing the particular program are inherent are respectfully traversed. To the contrary, it is not necessary that the recited elements be performed as recited. That something may occur or be present in the prior art, which applicants vigorously deny, is insufficient to establish inherency. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). In order to support a contention of inherency, the allegedly inherent characteristic must necessarily flow from the teachings of the reference. *In re Levy*, 17 USPQ2d 1461, 1464 (Bd Pat. App. & Inter. 1990). Accordingly, the Examiner is respectfully requested to provide a citation to a reference or an Examiner’s affidavit, or to withdraw the rejection. 37 CFR 1.104(d)(2); MPEP 2144.03.

For at least these reasons, the combination of features recited in independent claims 1, 7 and 9, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Chapin clearly fails to show other recited elements as well.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 7, and 9, but also because of additional features they recite in combination.

New claims 11 – 17 have been added to further define the invention, and are believed to be patentable for reasons including these set out above. Support for new claims 11 – 13 is located in the specification, for example, page 9, line 23 – page 10, line 4. Support for new claims 14 – 17 is located for example in original claims 2 – 3.

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any elements recited in the claims. However, applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

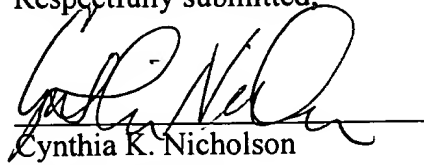
Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

The specification has been amended to remedy cosmetic defects.

In view of the foregoing, the applicant respectfully submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Cynthia K. Nicholson', written over a horizontal line.

Cynthia K. Nicholson

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